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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/759,179

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Chihiro Uematsu

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10/15/2008

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EXAMINER

MUMMERT, STEPHANIE KANE

ART UNIT

PAPER NUMBER

1637

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/759,179	Applicant(s) UEMATSU ET AL.
Examiner STEPHANIE K. MUMMERT	Art Unit 1637

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 September 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-7 and 14-16.
Claim(s) withdrawn from consideration: 10-13.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

/GARY BENZION/
Supervisory Patent Examiner, Art Unit 1637

/Stephanie K. Mummert/
Examiner, Art Unit 1637

Continuation of 11, does NOT place the application in condition for allowance because: The arguments are directed to amendments that were not entered for the reasons stated above, therefore the arguments are not persuasive and the arguments do not place the application in condition for allowance.

The translation of the Japanese patent application is acknowledged and has been entered as it is timely filed in response to the final rejection. In view of this translation, the rejection of claims 1-2, 9 and 15-16 as anticipated by Uematsu 2002 and the rejection of claims 3-7 and 14 as obvious over Uematsu 2002 are withdrawn.

Claims 1-7, 9 and 14-16 remain rejected, as noted above in view of the combined teaching of Whitcombe, Ovyn, Uematsu 2001 and Rizzo. It is noted that while Uematsu 2002 was used in the motivation statement the combination of the Whitcombe, Ovyn and Uematsu 2001 references are sufficient to render the claimed invention obvious in the absence of the teachings of Uematsu 2002.

Therefore, the claims remain rejected and no claims are allowed.

Continuation of 13, Other: The amendment to the claims introduces subject matter that has not been considered or searched previously. Therefore, these amendments raise new issues of search and consideration and will not be entered. Applicant's arguments on p. 7 of the remarks are noted, however, the portion of p. 29 of the office action referenced merely states that Applicant's arguments were not commensurate in scope with the claims. Beyond this discussion, limitations directed to "two or more target genes being derived from different samples" have not been considered previously during examination.

Furthermore, briefly responding to an assertion in the remarks, Applicant argues that the Ovyn reference has been misstated in the statement of rejection (p. 8 of remarks). This typographical error is acknowledged and it is noted that the Ovyn reference refers to US Patent 6,101,681, properly referenced in the 592 forms accompanying the office actions.